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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,659	04/08/2005	Dirk Heukelbach	05587-00377-US	7080

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EXAMINER	
NUTTER, NATHAN M	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/527,659	HEUKELBACH ET AL.	
	Examiner	Art Unit	
	Nathan M. Nutter	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 July 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-15,17-20 and 22-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-15,17-20 and 22-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 July 2009 has been entered.

Response to Amendment

In response to the amendment filed 2 July 2009, the following is placed in effect.

The objection to claim 6 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, is hereby expressly withdrawn in view of the cancellation thereof.

The rejection of claim 21 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, is hereby expressly withdrawn.

The rejection of claims 1-4, 6-15 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al (US 5,468,803) in view of Yamamoto et al (US 5,783,273) or Hirose et al (US 5,321,030), is hereby expressly withdrawn in view of applicants' amendment.

New grounds of rejection follow.

Claim Objections

Claims 19 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

The section of 37 CFR 1.75 (c) relied upon states:

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Claims 19 and 20 refer forward to claims 23 and 24, respectively.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10, 11 and 18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7-9, 22 and 24-28 of U.S. Patent No. 6,921,563 (Goerlitz et al). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims include the product of a thermoformable cyclic olefin copolymer composition comprising another polyolefin. Note claims 1, 5 and 6 of the patent, where that concept is addressed. The compositional limitations of the patent composition embraces those recited herein. Note claims 8 and 9 of the reference. A packaging material is produced (claims 22 and 24). The glass transition of the COC resin is within the range set out herein. The physical characteristics would be expected since all other parameters are overlapping. Choice of the particular end-product would certainly be within the purview of the artisan of ordinary skill.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10, 11 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Goerlitz et al (US 6,921,563).

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a)

might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The instant claims include the product of a thermoformable cyclic olefin copolymer composition comprising another polyolefin. Note claims 1, 5 and 6 of the patent, where that concept is addressed. The compositional limitations of the patent composition embraces those recited herein. Note claims 8 and 9 of the reference. A packaging material is produced (claims 22 and 24). The glass transition of the COC resin is within the range set out herein. The physical characteristics would be expected since all other parameters are overlapping. Choice of the particular end-product would certainly be within the purview of the artisan of ordinary skill.

Claims 1-4, 6-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oda et al (US 5,876,814) in combination with Otoi et al (US 6,682,797) in view of Yamamoto et al (US 5,783,273) or Hirose et al (US 5,321,030).

The reference to Oda et al teaches the production of film and sheet like articles, including packaging materials and container articles, through vacuum molding techniques, using cyclic olefin copolymers in combination with other polyolefins, as herein recited. Note column 3 (lines 16-25), column 9 (lines 57-60) and Examples 1, 2 and 3 for the thermomolding techniques. The articles are taught to have a thickness of "preferably 5 μm or more" at column 7 (lines 55-57) and a "thickness in total of from 80 to 600μ" at column 9 (lines 36-40). The cyclic olefin polymers (COC) employ identical monomers at column 4 (line 4) to column 6 (line 64), which possess glass transition temperatures embraced by those of the instant claims at 80º to 145°C and higher. Note the Abstract and column 2 (lines 23-35) which requires the "glass transition temperature (Tg) 10ºC or more higher than the temperature of said heat treatment."The use of an olefin comonomer is taught at the paragraph bridging column 6 to column 7. The reference teaches "(t)he molecular weight of the copolymer is not particularly restricted." The very broad number average molecular weight range of 500 to 2,000,000 is easily envisaged by the composition of the reference. Other unsaturated monomers may be employed for the COC at column 4 (lines 4-10). The heat of distortion would be above 121°C, as recited herein. Note the paragraph bridging column 7 to column 8 for the inclusion of other polymers, including polyolefins.

The reference to Oda et al does not provide any teaching of ranges for the heat distortion temperatures as recited in claims 10, 12 and 18, though the reference teaches the identical COC polymers. The heat of distortion for the reference polymers would be expected to be the same.

The Oda et al reference also fails to teach a suitable range of inclusion of additional polyolefin polymer.

The patent to Otoi et al shows the cyclic olefin copolymer blend with another polyolefin at 50 to 80% by weight at column 8 (lines 19-38). For 100 parts COC there may be added 100 parts by weight or less of polyolefin resin. The reference teaches the production of film and sheet like articles, including packaging materials and container articles, through vacuum molding techniques. Note column 9 (lines 31-44) of the patent for a disclosure of thermomolding. The cyclic olefin polymers (COC) employ identical monomers at column 4 (line 39) to column 5 (line 34), which possess glass transition temperatures embraced by those of the instant claims at 80º to 120°C and higher. Note column 10 (lines 41-57). The use of an olefin or other unsaturated comonomers is taught at column 5 (lines 21 et seq.). The reference teaches a weight average molecular weight of the copolymer to be “preferably 20,000 to 80,000,” within that recited herein. The heat of distortion would be above 121°C, as recited herein. Note column 8 (lines 19-37) for the inclusion of other polymers, including polyolefins. The reference to Otoi et al does not provide any teaching of ranges for the heat distortion temperatures as recited in claims 10, 12 and 18, though the reference teaches the identical COC

polymers. The heat of distortion for the reference polymers would be expected to be the same.

Neither reference to Oda et al and Otoi et al shows the manufacture of a blister pack, as recited in claim 11.

The references to Yamamoto et al (US 5,783,273) and Hirose et al are both relied upon to show the production of films having the specified thickness employed to form blister packs, as recited in claim 11.

Yamamoto et al show the production of multilayer laminates, suitable to produce blister packs. Note the Abstract. The reference employs the identical monomers as herein claimed. Note column 43 (lines 42-48) which shows a thickness of 150-5,000 μm, clearly within the ranges recited in claims 4 and 15. The reference employs the identical monomers, as herein recited and as taught by Takahashi et al, at column 5 (lines 1 et seq.). The reference shows a glass transition temperature of 30˚ - 180˚C at column 30 (lines 28-36). This high range would also be indicative of a high heat distortion resistance, as recited herein.

The patent to Hirose et al shows the manufacture of multilayer laminates, suitable for the production of blister packs, whose film thickness may be “in the range of 2 μm to 20 mm,” which embraces the recitations of claims 4 and 15. Note the Abstract. The reference employs the identical monomers used by Takahashi et al and employed herein. Note column 5 (lines 1 et seq.). The reference teaches a glass transition temperature range of “preferably -10˚ - 170˚C” at column 3 (lines 59-63).

The secondary references and the primary references to Oda et al and Otoi et al all show the use of the identical monomers in the manufacture of the cyclic olefin copolymer. Each shows the production of films. Yamamoto et al and Hirose et al show production of blister packs from such known compositions. Nothing on the record indicates unexpected or surprising results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

20 August 2009